REMARKS/ARGUMENTS

These remarks are submitted responsive to the Office Action dated March 28, 2005. As this response is timely filed within the 3-month shortened statutory period, no fee is believed due

In paragraphs 1 and 2 of the Office Action, claims 16-20 and 36-40 were rejected under 35 U.S.C. § 112, second paragraph. In paragraphs 3-4, claims 1-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,757,365 to Bogard (Bogard). In paragraph 5 of the Office Action, claims 1-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,694,007 to Lang, *et al.* (Lang).

Applicants have amended claims 16, 17, 18, 36, 37, and 38 to correct problems with antecedent basis and for clarity regarding the "other recipient". Applicants respectfully request that the 35 U.S.C. § 112 rejections be withdrawn responsive to these amendments. No new matter has been added.

Applicants have submitted Declarations supporting the removal of both Bogard and Lang as references. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0051 (the "Disclosure") entitled "Instant Messaging/Chat Client with 'Reply by Voice/Phone Conversation' Feature." The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as June 7, 2000, which predates the effective date of Bogard of October 16, 2000 and the effective date of Lang of March 22, 2001.

As to conception, Applicants are required to provide (from MPEP 715) facts showing a completion of the invention commensurate with the extent of the invention as claimed. In proving conception, Applicants can show that the differences between the claimed invention and the showing under 37 CFR § 1.131 would have been obvious to one of ordinary skill in the art. Such evidence is sufficient because Applicants' possession of what is shown carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art. Facts to be used in support of a 37 CFR § 1.131 Declaration (from MPEP 715.07) can include supporting statements by witnesses (MPEP 715.07 (G)) and disclosure documents (MPEP 715.07(H)).

The Disclosure is the completion of an IBM confidential disclosure form, which is a standardized document utilized by the International Business Machines Corporation (IBM) and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure, once the Disclosure has been completed. Any changes and/or additions are appended to an attachment to the IBM confidential disclosure form along with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since June 7, 2000.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present Application, including each claim within the present Application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the United States Patent and Trademark Office (USPTO), the inventors reviewed the Application to insure that the claims and material contained therein were fully supported by the Disclosure. The above facts are certified to be true to the knowledge of the undersigned and have been sworn to by the inventors in paragraphs 2-6 of the submitted Declarations.

Additionally, in the Application claims are fully supported by the Disclosure. For example, claim 1 includes the limitations shown below, which include annotations (in bold) showing a disclosure section that supports the corresponding limitation.

1. *An instant message (IM) communication method comprising the steps of:*

inserting in an IM a voice communications identifier **(inherent in the disclosure since a person can select a symbol or icon and since from paragraph 2 of the disclosure the person does not have to understand how to make the voice connection)**

transmitting said IM to a recipient; and, **(Inherent in an instant messaging session)**

responsive to said recipient selecting said voice communications identifier, establishing a voice communications link with said recipient. **(inherent in the disclosure since a person can select a symbol or icon and since from paragraph 2 of the disclosure the person does not have to understand how to make the voice connection)**

Turning from conception to diligence, Applicants exercised diligence from prior to the effective date of both Bogard (October 16, 2000) and Lang (March 22, 2001) to July 19, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure, at which time the Application is expeditiously filed with the USPTO. The above facts are certified to be true to the knowledge of the undersigned and have been sworn by the inventors in paragraphs 2-6 of the submitted Declarations.

As to the period between October 16, 2000 (Bogard) or March 22, 2001 (Lang) and July 19, 2001, this was a time period in which outside counsel spent drafting the present application and iteratively reviewing and revising the drafted application with the inventors until it was finalized in its submitted form. Applicants draft many applications for different clients. In drafting applications, Applicants establish a queue of applications that are generally handled in a first-in / first out basis based upon the workload of drafters having expertise in the area of the patent. Applications within the work queue having potential bar dates or that are to be expedited for some other reason, are able to be moved to the head of the work queue on occasion. The above noted practice is a standard industry practice for patent drafting firms.

The activity above (*reasonable time spent drafting and reviewing a patent application*) is believed to fall within the legal requirements for a showing of diligence under MPEP 715.07(a). Applicants have included the following documents as proof of the afore described activity for purposes of diligence.

* October 2, 2000 document from client requesting undersigned outside counsel prepare the instant patent on their behalf.

* October 11, 2000 document from undersigned outside counsel to client confirming that undersigned outside counsel would prepare the application for the client.

* January 2, 2001, March 2, 2001, April 2, 2001, May 2, 2001, June 2, 2001, and July 3, 2001 docket notes showing the instant patent was placed in the queue of patents to be prepared and showing the status of the patent application.

* April 19, 2001 document presenting an initial application draft to the inventors (start of iterative review / adjustment process between drafter and inventors noted below and within the signed Declarations).

* July 9, 2001 document showing the final draft for the application being sent to the inventors for approval.

In light of the above, Applicants have shown that the present invention was conceived before the effective date of both Bogard and Lang and that legally sufficient diligence was exercised in constructively reducing the invention to practice at least in regard to the critical time period between just prior to the effective date of both Bogard and Lang until the filing date was exercised. Accordingly, both Bogard and Lang should be withdrawn as a reference for purposes of 35 U.S.C. § 102(e), which action is respectfully requested. Withdrawal of both Bogard and Lang as references should result in a withdrawal of the rejections with respect to claims 1-44, which action is respectfully requested.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the

undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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